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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/576,672

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Makoto Sanpei

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03/25/2010

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EXAMINER

LENIHAN, JEFFREY S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/25/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/576,672 | <b>Applicant(s)</b><br>SANPEI ET AL. |  |
|                              | <b>Examiner</b><br>Jeffrey Lenihan   | <b>Art Unit</b><br>1796              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This Office Action is responsive to the amendment filed on 12/30/2009.
2. The objections and rejections not addressed below are deemed withdrawn.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

### *Response to Amendment*

4. The amendment to the claims filed on 12/30/2009 does not comply with the requirements of 37 CFR 1.121(c), an excerpt of which is shown below, because new claims 9-12 should not contain underlined text.. Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. **Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings** (emphasis added). If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

5. In the interest of expediting prosecution, the amended claims have been examined on the merits. Any future submissions will be required to comply with the requirements of 37 C.F.R. 1.121(c).

***Claim Rejections - 35 USC § 103***

6. Claims 1-6 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikemoto et al, US2002/0068797 (of record), in view of Yang et al, US2004/0106723 (of record), and Hong, US2004/0226393 (of record).

7. The rejection stands as per the reasons outlined in the previous Office Actions, incorporated herein by reference (for claims 1-6). Regarding new claims 9-12, limitations regarding the claimed components (a), (b), and (c) are discussed in the previous Office Actions with regards to claims 1-6.

8. Regarding the range of propylene content: It has been held that a *prima facie* case of obviousness exists where the claimed ranges and the prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, see *Titanium Metals Corp. of America v. Banner* 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Per applicant's remarks (page 12, lines 9-12), the propylene content in the composition of Ikemoto is 48%. Barring a showing of factual evidence demonstrating unexpected results, one of ordinary skill in the art would reasonably expect that the properties of a composition wherein the propylene content is 46.7% by weight, would not be materially different from the prior art composition having a propylene content of 48% (for claims 9, 10). Additionally, Ikemoto teaches that the ethylene content of the rubbers used falls within the range of 48-70% by weight (¶0018); by extension, it would therefore be obvious to use rubbers wherein the propylene content falls within the range of 30-52% by weight (for claims 11, 12).

***Response to Arguments***

9. Applicant's arguments filed 12/30/2009 have been fully considered but they are not persuasive.

10. Regarding the number average molecular weight ( $M_n$ ) of the oligomer component: As noted by applicant in the remarks (see page 11), Yang discloses the  $M_n$  of the oligomer additive falls within the broad range of 100-21,000; Yang further discloses the narrower range of 200-500 for some embodiments of said oligomer. The mere fact that the lower limit of 200 disclosed by Yang is less than the claimed lower limit of 300 does not teach away from the use of the overlapping portion of the prior art range and the claimed range. Applicant argues that the statement in the specification that oligomers having  $M_n$  less than 300 are not suitable for use in the claimed invention establishes the criticality of the claimed range; this is not persuasive. Applicant has not provided factual evidence to substantiate this allegation. Applicant's specification only compares the effects of the use of an oligomer having  $M_n$  of 690 (Examples 1-3) to oligomers having  $M_n$  of 287 (Comparative Example 4) or 2000 (Comparative Example 5). Applicant has not established that unexpected results are obtained commensurate in scope with the claimed range.

11. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the amount of the oligomer is dependent on the propylene content of the rubber) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

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See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims only recite that the oligomer content falls within specific ranges reported in terms of parts by weight (pbw).

12. Applicant's arguments regarding the use of the oligomer of Yang with an EPDM were previously addressed in the Advisory Action mailed on 11/03/2009, incorporated herein by reference.

13. Applicant appears to argue that unexpected results are obtained by the use of an  $\alpha$ -olefin oligomer versus the use of a paraffinic plasticizer. The examiner notes that Yang discloses examples wherein commercially available  $\alpha$ -olefin oligomers are used as plasticizers by without the addition of a paraffinic plasticizer (see ¶0352 Table 6, Samples 7-9). The difference between the claimed invention and prior art therefore is not the addition of an  $\alpha$ -olefin oligomer instead of a paraffinic plasticizer; rather, the difference is the selection of the overlapping portion of the claimed  $M_n$  range and the prior art  $M_n$  range as discussed above.

### **Conclusion**

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Lenihan whose telephone number is (571)270-5452. The examiner can normally be reached on Monday through Thursday from 7:30-5:00 PM, and on alternate Fridays from 7:30-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/  
Primary Examiner, Art Unit 1796

/Jeffrey Lenihan/  
Examiner, Art Unit 1796

/JL/